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REMARKS

Claims 1-25 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-25 Under 35 USC §103(a)

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schneier (Applied Cryptography Second Edition: protocols, algorithms and source code in C, 1996) and Pinkert, *et al.* (Operating Systems: concepts, policies and mechanisms, 1989). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Schneier nor Pinkert, *et al.*, alone or in combination, teach or suggest applicants' invention as recited in the subject claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 1 (and similarly independent claims 9-11 and 16) recites *a method to authenticate a service by making a request to a first party utilizing a first alias and searching a list of aliases associated with the service... then allowing a second party making the request to access the service if a match is found between the first alias and at least one alias in the list of aliases.*

In particular, an aspect of the claimed invention discloses a method to authenticate a service (e.g., Kerberos) by making a request to a domain controller, searching a list of Service Principal Names (SPNs) associated with the service, and

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enabling a second party to access the service if a match is found between the first SPN and at least one other SPN of the list of SPNs. Neither Schneier nor Pinkert *et al.* disclose or suggest such claimed aspects of applicants' invention.

In the Office Action dated September 23, 2003, the Examiner cites Schneier, p.567 to teach "wherein the search results for the search match results for the key words are...in which a search match for a first number of the one or more search engines displayed..." However, this quotation is not mentioned in the page cited by the Examiner. Instead, this passage is directed to how a client and server may communicate with each other utilizing Kerberos. Moreover, such quotation is not found anywhere in the reference. Even if such aspects of Schneier are implicit in the reference, they are not germane to the novel claimed features of the subject invention.

In addition, there is no motivation or suggestion to combine the references Schneier or Pinkert *et al.* to teach the limitations of the subject invention. In order to reject claims in an application pursuant to §103, there must be some logical reason apparent from *positive, concrete evidence* of record which justifies a combination of primary and secondary references. See *In re Lakowski* 871 F.2d 115; 10 U.S.P.Q.2D (BNA) 1397 (Fed. Cir. 1989) citing *In re Regel*, 526 F.2d 1399, 1403 n.6, 188 USPQ 136, 140 n.6 (CCPA 1975). A challenger to the validity of a patent cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; the *challenger has the burden to show some teaching or suggestion* in the references to support their use in the particular claimed combination. See *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988).

In particular, Schneier discloses using aliases to reference the same physical file by different logical names and Pinkert *et al.* to a trusted third party authentication protocol. The Examiner cites the motivation to combine the cited references as allowing "users to reference the same physical file by different logical names." (See Pinkert, *et al.*, p. 205, ¶8). However, merely providing the definition of an alias from Pinkert, *et al.* does not provide the motivation or suggestion to combine the reference with Schneier. Nowhere does Pinkert, *et al.* mention the use of aliasing in conjunction with the third party authentication protocol disclosed in Schneier. Similarly, there is no mention in

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Schneier of utilizing aliasing with a third party trusted authentication system. Thus, the Examiner's burden to show a motivation to combine Pinkert *et al.* with Schneier is not met and the combination of such references is improper.

It appears the Examiner is impermissibly employing 20/20 hindsight with applicants' specification as a roadmap to make the purported combination. The rationale proffered to modify and combine Schneier and Pinkert *et al.* is to achieve benefits identified in applicants' specification, which overcome problems associated with conventional systems and/or methods. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the Court of Appeals for the Federal Circuit. *See, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of at least the foregoing, it is readily apparent that there is no suggestion or motivation to combine Schneier and Pinkert *et al.* and the references do not make obvious the subject invention as disclosed in independent claims 1, 9-11 and 16 (and claims 2-8, 12-15 and 17-25 which respectively depend therefrom). This rejection should be withdrawn.

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II. Conclusion

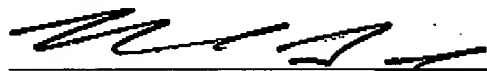
The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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